

REMARKS/ARGUMENTS

Claims 4, 5, 7-9 and 14-19 have been rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. These claims were rejected for lack of proper antecedent basis. This was due to typographical errors in the dependence of these claims. Claims 4 and 5 have been amended to claim dependence on claim 3, claims 7-9 have been amended to claim dependence on claim 6 and claims 14-19 have been amended to claim dependence on claim 13. The elements in these dependent claims now have proper antecedent basis.

Claim 21 has been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is improper in that it fails to recognize the useful, concrete and tangible result of the claim. 35 U.S.C. §101 precludes abstract ideas from patentability, however, claim 21 claims the act of “modifying said print task with said print processor,” which is a useful, concrete and tangible result of the claimed signal. A practical application of an abstract idea is patentable if it produces a useful, concrete and tangible result. *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1601-02 (Fed. Cir 1998). The examiner misstates that “The computer data signal, print task, print task modification and print processor can all be represented as software consisting of binary numbers” and concludes that this renders the claimed invention unpatentable. This is incorrect. Similar software applications have been held patentable by the Federal Circuit when those applications did no more than manipulate numbers for a useful result. *AT&T Corp. V. Excel Comm. Inc.*, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). In *AT&T*, the useful result was a modified long-distance telephone bill, in this application, the useful result is a modified print task. The USPTO, has long endorsed

this type of "propagated signal" claim in their training guidelines for computer-related inventions. A computer data signal is typically regarded as equivalent to a computer readable medium.

The examiner apparently further rejects claim 21 as some type of non-functional data structure and states that the elements of this claim are not capable of causing functional change in the computer. Claim 21 is not directed to a data structure. It is directed to a computer data signal that causes a computer to execute specific instructions using a specific component of the computer system to achieve a specific result. No specific data structure is described and every element of the claim is directed to a function of a computer component. The examiner is requested to reconsider this rejection.

Claims 1-7, 10, 13 and 19-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Owa et al (U.S. Patent No. 6,348,971). However, this rejection is improper because it fails to present a prima facie case of obviousness. The examiner cites Owa et al (col. 5, lines 34-41) as disclosing the element of "sending print task modification commands to said print processor." However, this location in Owa et al reads as follows:

Then, the output destination printer selection section 11 obtains the basic information on the printers as illustrated in FIG. 3, retained in the basic information setting section 12, the printer selection conditions preset by the user as illustrated in FIG. 5, set in the printer selection condition setting section 15, and the user print conditions set in the user print condition input section 14 at step S3.

This specific reference discloses some method of storing and accessing printer selection and printer condition data, however, it does not teach any form of "sending print task modification commands to a print processor,"

The examiner also cites Owa et al (col. 9, lines 50-60) as disclosing the element of “modifying said print task with said print processor.” However, this location in Owa et al reads as follows:

The printer driver 44 is made up of a core driver 44A and execution modules 44B designated by the core driver 44A. The core driver 44A designates required execution modules specified by module configuration information from an execution module group 53 in the storage section 50 and loads the execution modules into memory, thereby providing a functional configuration fitted to a selected printer. Thus, the core driver 44A itself does not comprise a print data generation function, but rather designates and connects necessary execution modules, thereby configuring the optimum printer driver 44.

Again, this reference does not disclose anything related to “modifying said print task with said print processor.” Owa et al, at this location, seem to disclose a method for tailoring a print driver for a specific printer.

The examiner seems to be confusing a “print processor” with a printer driver. A printer driver is a printer-specific component that converts a print task from a generic format to a format that is readable by a specific printer. Because of the printer-specific nature of a printer driver, a different driver must be used for each printer model or printer family. Incorporating functionality into a printer driver can only be done for the specific printers with which the driver functions. Therefore, many drivers must be created to apply a function to an entire line of printers. A print processor is not printer-specific. A single print processor can be used with a wide variety of printers. Accordingly, a modifying print processor has advantages over and functions differently than a printer driver that achieves a similar result.

The differences between a print processor and a printer driver are explained in Owa (col. 9, lines 33-37, lines 61-65 and Fig. 8). Owa et al distinguish a printer driver from a print processor clearly in Figure 8 where a driver 44 is shown as a different element than the print processor 45. These components are also listed separately at col. 9, line 34. Owa et al never disclose any functionality or “intelligence” in the print processor. In fact, Owa et al teach away from an intelligent print processor or “modifying print processor” by describing the print processor’s function as “a buffer for transferring the print data” (col. 9, lines 63-64). A buffer is typically a “dumb” memory element for temporary data storage that, by nature, performs no modification of the data stored therein. This is obviously very different from the “modifying print processor” of claim 1 that actually modifies the print task.

Accordingly, the modifying print processor element or act found in claims 1-7, 10, 13 and 19-23 fully distinguishes these claims from the disclosure taught by Owa et al.

Claims 8, 9, 17 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Owa et al (U.S. Patent No. 6,348,971) in view of Shimada (U.S. Patent No. 6,654,136). However, this rejection is improper because it fails to present a prima facie case of obviousness. Each of these claims is dependent on claim 1 or 13 and is, therefore, patentable for the reasons stated above. Regardless of any copy-splitting disclosure in Shimada, these claims are patentable by virtue of their print processor elements.

Claims 11 and 12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Owa et al (U.S. Patent No. 6,348,971) in view of Onuma (U.S. Patent No. 6,570,669). However, this rejection is improper because it fails to present a prima facie case of obviousness. Each of these claims is dependent on claim 1 and is, therefore, patentable for the reasons stated above.

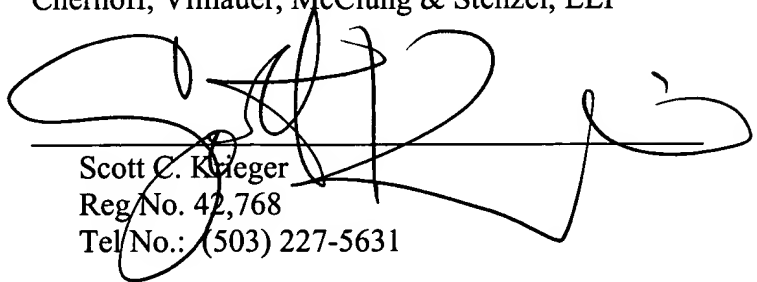
Appl. No. 09/681,208
Amdt. dated January 19, 2005
Reply to Office action of October 22, 2004

Regardless of any disclosure of a use of a printer-ready file in Shimada, these claims are patentable by virtue of their print processor elements.

Accordingly, these claims are patentable and the applicant respectfully requests that the examiner allow these claims as amended.

Respectfully submitted,

Chernoff, Vilhauer, McClung & Stenzel, LLP



Scott C. Kleger
Reg No. 42,768
Tel No.: (503) 227-5631